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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,847	03/18/2004	Yotaro Sanada	SON-1951/DIV	5850

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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,847

Applicant(s)

SANADA ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/711,274.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Divisional

Application Serial Number 10/802,847, is a divisional of U.S. Patent Application Serial Number 09/711,274, filed on November 10, 2000, now U.S. patent No. 6,741,537

In an amendment filed on March 18, 2004, the Applicants cancelled claims 1-4 and presented newly submitted claims 4-12 for consideration on the merits.

Claim Rejections - 35 USC § 112

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification (i.e., the parent application SN 09/711,274)) in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Note that this application was not filed as a continuation-in-part, but was filed expressly as a divisional application.

With regard to claim 10, the phrase “wherein *each* one of the *four* holes has a first cylindrical portion and a second cylindrical portion in communication with the first cylindrical portion, the first cylindrical portion having a first diameter and the second cylindrical portion having a second diameter being smaller than the first diameter” appears to have no support in the originally filed parent application.

That is, only two holes appear to have this feature, and not all four as set forth in claims 10, and by extension, claim 11.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Goto (US 5,898,659).

As per claim 4, Goto (US 5,898,659) discloses a disk cartridge (1) having a disk (disk provide inside cartridge (1)) and a cartridge enclosing said disk, comprising: a positioning aperture (e.g., 5) for accepting a first positioning pin having a first height-positioning base and provided in a disk recording reproducing apparatus (intended usage phraseology) to be installed and positioning said cartridge relative to said disk recording reproducing apparatus; an escaping aperture (e.g., either of the right side (5) as depicted in FIG. 1, or, either of the recessed holes of the four depicted (7) holes or either of the two the indents (6)) for accepting a second positioning pin having a second height-positioning base for escaping said second positioning pin without contacting said cartridge.

It is noted that the claims are directed to a disk cartridge, *per se*. Thus, the cartridge of Goto (US 5,898,659) has the capability of being used with a recording apparatus designed such

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that any of holes (7), (6) and/or (5) can function as positioning and/or escaping holes, since they are indeed holes which are formed on a lower side of the disk cartridge (1).

As per claim 5, wherein said escaping aperture (e.g., one of (5), (6) and/or (7)) is provided outside of an outer periphery of said disk.

As per claim 6, wherein said escaping aperture is provided outside of an outer periphery of said disk and inside of said positioning aperture. For example, (7) is positioned outside of (6) (when (6) is construed to be the positioning aperture, of (7) closest to (5) is seen to be positioned outside of (5)), etc.

As per claim 7, the disk cartridge of Goto (US 5,898,659) is designed such that a disk encompassed therewithin has a diameter not to contact with a first positioning pin (e.g., pin inserted into either of (5), (6) and/or (7) having a first height-positioning base and provided in a disk recording reproducing apparatus to be installed (again, "intended usage - the claim is directed not to a disk cartridge and disk apparatus in combination, but a disk cartridge, *per se*); and a positioning aperture (e.g., one of (5) and/or (6) and/or (7) which all have the capability to receive a particular "positioning pin" is a recording apparatus designed to used the apertures as either escape apertures and/or positioning apertures) for accepting a second positioning pin having a second height-positioning base and provided in said disk recording reproducing apparatus.

Note that the claims 4-7 are drawn to a disk cartridge, *per se*. Additionally, in some claims, the phrase "to be" is not only an intended use recitation, but implies an event that may, or may not, occur in the future. That is, there is no positively recited structure that would define over the device as disclosed by Goto (US 5,898,659). The disk cartridge of Goto (US 5,898,659)

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is clearly *capable* of accepting pins designed to interact with the holes (5)-(7), such that the holes (5)-(7) structurally function as either positioning holes and/or escaping holes. More concretely, claims 4-12 are anticipated by Goto (US 5,898,659) since there is no positive recitation of a disk apparatus/cartridge that results in a structural difference between the claims 4-12 and Goto (US 5,898,659). As has been widely held in patent law, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable* of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 7-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Omori et al. (JP 5-135465 A).

Omori et al. (JP 5-135465 A) discloses a disk cartridge (1) of Goto (US 5,898,659) is generally a rectangularly-shaped housing (1) extending longitudinally and laterally and including an upper shell (8a) and a lower shell (8b) connected together in a facially opposing manner to form a disk-receiving compartment therebetween; and a disk (2) rotatably mounted to and between the upper and lower shells (8a, 8b) in the disk-receiving compartment, wherein the lower (8b) shell includes four holes (18, 18, 19, 19) formed therein and extending towards the upper shell (8a), the four holes (18, 18, 19, 19) disposed radially outwardly relative to the disk (2) with each one of the four holes positioned in a respective corner portion of the housing (1) - see, e.g., FIG. 1.

As per claim 9, wherein each one of the four holes (18, 18, 19, 19) is cylindrically shaped - see FIG. 3 (surfaces includes closed curves which form the holes (18, 18, 19, 19)).

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As per claim 12, wherein the four holes (18, 18, 19, 19) are arranged in plan view such that imaginary straight lines extending from each hole to neighboring lateral and longitudinal holes form a rectangular configuration - see FIGS. 3 and/or 4).


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William J. Klimowicz
Primary Examiner
Art Unit 2652

WJK